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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,643	03/20/2002	Richard Fayer-Hosken	235.00300101	1109
26813	7590	10/21/2005	EXAMINER	
MUETING, RAASCH & GEBHARDT, P.A. P.O. BOX 581415 MINNEAPOLIS, MN 55458			NOLAN, PATRICK J	
			ART UNIT	PAPER NUMBER
			1644	

DATE MAILED: 10/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/019,643	FAYRER-HOSKEN ET AL.
	<b>Examiner</b> Patrick J. Nolan	<b>Art Unit</b> 1644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 29 July 2005.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 4,6,12-21,23,27-29 and 41-43 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 4,6,12-15,17,18,21,23,29,41 and 42 is/are rejected.

7)  Claim(s) 16,19,20, 27-28 and 43 is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
    Paper No(s)/Mail Date .  
4)  Interview Summary (PTO-413)  
    Paper No(s)/Mail Date. \_\_\_\_ .  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_

1. Claims 4, 6, 12-21, 23, 27-29 and newly added claims 41-43 are pending.

2. INTERFERENCE

At least claim(s) 4, 6, 12, 13, 14, 15, 17, 18, 21, 23, 29 and newly added claims 41 and 52 of the application are believed to interfere (35 U.S.C. § 135(a)) with at least claim(s) 11 and 21 of U.S. Patent 6,790,457. The patent claims priority of U.S. (or foreign identified by country) application 60/113,526 and appears to be entitled to benefit for the purpose of a priority contest under 35 U.S.C. § 135(a).

The patent is not prior art under 35 U.S.C. § 102(e). See, e.g., In re Hilmer, 359 F.2d 859, 149 USPQ 480 (CCPA 1966). Nevertheless, a patent cannot be issued to applicant until it prevails in an interference with the patent. In any interference, applicant would be the junior party.

Accordingly, applicant is required to make a showing under 37 CFR § 41.202(d) (see Notice of Final Rule, 69 Fed. Reg. 49960, 50019 (Aug. 12, 2004)) as to why it would prevail in an interference with the patent. Pursuant to 37 CFR 41.202(c), applicant must also comply with the requirements set forth in 37 CFR 41.202(a)(2)-(a)(6).

Note that "New evidence in support of priority will not be admitted except on a showing of good cause." 37 CFR § 41.202(d)(2); Hahn v. Wong, 892 F.2d 1028, 13 USPQ 1313 (Fed. Cir. 1989); Huston v. Ladner, 973 F.2d 1564, 23 USPQ2d 1910 (Fed. Cir. 1992). Hence, applicant should not expect to make a showing in the first instance after the application is forwarded to the board for a determination of whether an interference should be declared.

A shortened statutory period for reply to this communication is set to expire THREE MONTHS from the mailing date of this action. Extensions of time may be granted under 37 CFR 1.136(a). **In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this communication.**

If a showing is timely presented, it will be forwarded to the board where it will be evaluated pursuant to 37 CFR § 41.202(e). If at the end of the six-month period, a showing is not timely presented, the application will be forwarded to the board where it would be expected that an order to show cause would be issued pursuant to 37 CFR § 41.202(d)(2).

Applicant's arguments filed 7-29-05 have been fully considered but are not found persuasive.

Applicant argues that by amending the claims to "heterologous" the potential interfering subject matter is obviated.

However upon a review of the '457 patent it is clear in columns 12-13, that immunization of birds with antigens from the IPVL, are derived from birds of a different species but closely related. Since the term "heterologous" in the instant application is defined on page 11, as "derived from a species that is different from, more preferable remote from the species of the vaccinated organism", the claimed invention in the '457 patent when read in light of their specification encompasses "heterologous" species vaccination, in fact the '457 patent prefers it.

In addition claims 41 and 42 are included since the '457 patent clearly teaches using non-oil adjuvants in their immunogenic vaccine compositions for treating birds.

Lastly, claims 11 and 21 of the '457 patent are the correct claims for the interfering subject matter not claims 12 and 21.

3. Claim 43 is objected to because of the following informalities: STDCM is misspelled.

Appropriate correction is required.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

6. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick Nolan whose telephone number is 571-272-0847.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Christina Chan, can be reached at 571-272-0841.



Patrick J. Nolan, Ph.D.

Primary Examiner, Group 1640

10/14/05